

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue		Confirmation No.
Application No. :	09/902,475	7468
Applicant	: Briere, <i>et al.</i>	
Filed	: July 9, 2001	
Title	: BLOW MOLDING DEVICE FOR PRODUCING THERMOPLASTIC CONTAINERS	
Art Unit	: 1722	
Examiner	: Robert B. Davis	
Docket No.	: 011496/236625	
Customer No.	: 00826	

Mail Stop Reissue  
Commissioner for Patents  
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**Applicant's Summary of Interview and Supplemental Remarks**

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Commissioner:

The above-identified application is a continuation of an application for reissue of U.S. Patent No. 5,968,560. The application for reissue remains pending and bears application serial number 09/553,413.

In response to the Interview granted by Examiner Davis on May 3, 2006, applicant hereby submits its summary of interview and supplemental remarks.

**Summary of Interview** begins on page 2 of this paper.

**Remarks** begin on page 3 of this paper.

### **Applicant's Summary of Interview**

The Applicants thank Examiner Davis for the courtesy of a personal interview granted to Applicants' attorney Jeffrey Young on May 3, 2006, to discuss the amended claims filed May 2, 2006, in response to the final office action mailed November 2, 2005, and the IDS filed May 2, 2006. Claims 22-31 and 45-50 were discussed (Claims 32-44 having been canceled in the amendment). The Examiner's summary of the interview pointed out that agreement was not reached as to all the claims, although it was agreed that Claims 22-47 appear to overcome the recapture rejection. The Examiner's statement of the substance of the interview is comprehensive, and is reproduced here:

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. Young discussed the amendment filed 5/2/06 and the claims in light of the decision by the Board of Appeals in parent application 09/553,413. It was agreed that claims 22-47 were allowable in view of the claims reciting the limitation "the shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures moveable one with respect to the other". The examiner stated that since 22-47 were directed to the subcombination of the shell holders and included the implicit limitation as defined by the Board that the claims appear to overcome the recapture rejection. The examiner could not agree that claims 48 and 50 overcome the recapture rejection. The examiner stated that the shell being defined in terms of the encompassing shell holders did not appear to overcome the recapture rejection. The examiner felt that the shape of the encompassing carriers does further limit the shape of the shell holders as stated by the Board, but not the element supported interiorly of the shell holder. The examiner stated that a supplemental declaration must be submitted for claims 22-47 to be passed to issue.

In addition, the Examiner viewed the references submitted in the May 2, 2006, IDS, and preliminarily concluded that they did not impact his conclusion that the claims distinguish the prior art. Applicants' attorney argued that the language of Claims 48-50 does provide a basis for concluding that the mold shell ("the element supported interiorly of the shell holder") is sufficiently limited for recapture purposes, because it does have to be shaped to be received by the encompassing mold carrier. While this seemed to be undisputed, the Examiner argued that the mold shell is too far removed from the mold carrier in the structure to be implicitly limited by the shape of the mold shell holder, and therefore not within the scope of what the Board of Appeals allowed in the parent reissue application. The Examiner asserted that prior art mold shells would fit this requirement and therefore that there was no effective narrowing of the mold shell along the lines of the original amendment of the mold carrier.

### Supplemental Remarks

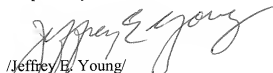
The Applicants disagree with the Examiner's interpretation of recapture law as requiring that the limitation corresponding to the original amendment must distinguish the prior art. The Federal Circuit *Clement* and *Pannu* decisions require that even when one relies on new limitations for patentability (here, the quick fixing locks or dual axial positioning assemblies) one still must narrow the claims with respect to the limitation relied upon to overcome the prior art rejection. *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Pannu v. Storz Instruments*, 258 F.3d 1366 (Fed. Cir. 2001). However, the Board of Appeals and Interferences, in interpreting these cases and others, clearly rejected a rule that would require reissue claims to retain each and every limitation added or argued during the prosecution of the original patent to overcome a rejection, and further refused to define "surrendered subject matter" in the same way for reissue as it is defined for purposes of prosecution history estoppel. *Ex parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Interf. May 29, 2003)(Text at n. 9; n. 21). In contrast, the Board found that when a patentee has made an error in limiting the claims more than was required, this is the type of error which can be corrected by reissue given the remedial nature of the statute. *Eggert*, (Text at n. 22).

Claims 48-50 seek to remediate the patentee's error of not claiming the patentable aspects of the mold shell as a subcombination. This error is not related to the rejection of the claims surrendered in the original prosecution. The new limitations narrow these claims and prevent them from covering the same subject matter that the claims covered before the encompassing mold carrier amendment. Furthermore, these claims are narrowed in an aspect germane to the prior art rejection, by requiring that each mold shell is configured to be supported by an enveloping mold carrier via an interposed mold shell holder shaped to be received by the enveloping mold carrier. And, the claim limitation added to get the '560 patent issued implicitly limits the shape of the mold shells to shapes that can be supported by an enveloping mold carrier via an interposed mold shell holder shaped to be received by the enveloping mold carrier, just as the Board determined that the shell holders were implicitly limited.

The Applicants submit, therefore, that the requirement for a limitation related to the surrendered subject matter is met by a limitation related to the encompassing mold carrier, even though that limitation by itself does not distinguish the prior art. The requirement is only that the claim be narrower in regard to that element than the surrendered subject matter, which clearly is the case for Claims 48-50. To hold otherwise would be to follow a reissue rule expressly rejected by the Board. The case law clearly does not estop Applicants from correcting their error, which will not result in surrendered subject matter creeping back into the claim. Thus, Applicants submit that the limitation on the mold shells to be configured to be encompassed by the mold carrier via the mold shell holder is sufficient to avoid recapture.

Should the Examiner have further questions or comments with respect to examination of this case, it is respectfully requested that the Examiner telephone the undersigned so that further examination of this application can be expedited.

Respectfully submitted,



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